

REMARKS

Claims 16-25 were pending, examined and rejected in the December 23, 2003 Office Action. The Examiner's Detailed Action is merely a word-processed recitation of his Rejections found in the non-final Office Action dated July 3, 2003. Accordingly, Applicant incorporates herein by reference its Response, dated October 3, 2003, to that Office Action. Applicant notes that the present Final Office Action includes a Response to Arguments from Applicant that states that Applicant's arguments have be "fully considered," but are considered unpersuasive. However, the Examiner does not address Applicant's arguments regarding the Weismann '351 patent (claims 21-23). Accordingly, Applicant respectfully submits that the Board of Patent Appeals and Interferences would find the Examiner's reasons for rejections unpersuasive and inadequate to carry the burden of the Patent Office.

The Office is required to make a prima facie case of obviousness under 35 U.S.C. § 103 to support a final rejection of the claims of an application. The standard for obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). See also MPEP § 706. Under Graham and MPEP § 706.02, an analysis for obviousness must include:

- (1) identifying the differences in the claims over the applied references;
- (2) setting forth the proposed modification of the applied references necessary to arrive at the claimed subject matter; and
- (3) explaining why the proposed modification would be obvious.

To satisfy the third step of Graham, the Office must identify where the prior art provides a motivating suggestion to make the modifications proposed in the second step. Before the Office may combine the disclosures of the applied references, the Office must identify some suggestion for doing so either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d

347, 351, 21 USPQ2d 1941, 1943-44 (Fed Cir. 1992). Simply because the references may be modified as suggested by the Examiner does not make the modification or the claimed invention obvious, unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Here, the Office has failed in its burden to make a *prima facie* case of obviousness.

To support an obviousness rejection there must be some suggestion or motivation to modify a reference or combine reference teachings -- see MPEP § 706.02(j). The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness -- see MPEP § 2143.01. In addition, merely because the claimed invention may be within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness -- *Id.* Moreover, the prior art must suggest the desirability of the claimed invention -- *Id.* There is no such suggestion in the cited references. Without such a teaching or suggestion to combine the references, the Examiner is using improper hindsight to glean from Applicant's teachings that which is not disclosed in the prior art. See In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

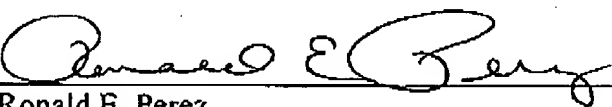
It is insufficient to merely recite, as the Examiner does in his Response to Arguments, that the references are analogous (i.e., both references provide inspiratory gas to the patient). Whether the references show that the features of Applicant's claimed invention are "generally available to one of ordinary skill in the art" is unavailing. The Office must show where the teaching or suggestion to combine such features appears in the applied reference. See In re Rijckaert, 9 F.3d 1531, 1533-34, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). To support an obviousness rejection, the prior art must suggest the desirability and thus the obviousness of making the claimed combination, without the slightest recourse to Applicant's teachings. See In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397 (Fed. Cir. 1989). There is no such suggestion in either of the applied references. Nor has the Office has provided other prior art that suggests modification of the references to achieve Applicant's claimed breathing aid device.

The Office has not pointed to anything that would lead one of ordinary skill in the art to combine the teachings of the references. The Examiner's conclusory and unsupported statements that it "would have been obvious ... because it prevents ..." is insufficient to maintain a rejection under § 103. Furthermore, Applicant has found nothing in the Obermayer '172 patent indicates that it is an objective of that invention to alternate the open/closed states of the inspiration/expiration valves to prevent waste of breathing gas, which is typically air, and that such switching would increase efficiency and lower costs. Such alleged benefits are not stated objectives of Applicant's invention, and were apparently created from whole cloth by the Examiner. Moreover, Applicant submits that such valve switching is not necessarily efficient and would increase the operating costs of the Siemens Servo Ventilator 300.

Applicant respectfully submits that the Examiner's position is contrary to the facts and the law, and cannot be maintained on appeal. Consequently, Applicant request that the rejections under 35 U.S.C. § 103 be withdrawn and the application passed to issue.

Respectfully submitted,

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